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Application No. 10/804,719

REMARKS

The Examiner noted that only corrected section of the non-compliant amendment document must be resubmitted (in its entirety). In this instance, the entire "Amendment to the Specification" section, the Abstract, and the "Amendments to the Claims" section of applicants' amendment document filed on August 31, 2006 must be resubmitted.

The entire amendment document filed on August 31, 2006, is submitted because additional amendments have been made. The specification has been amended to show proper markings to indicate deleted text and to indicate added text. The amended Abstract appears on a separate sheet and the "Amendments to the Claims" section is also submitted herewith on a separate sheet.

Reconsideration and withdrawal of the notice of non-compliant amendment is respectfully requested.

Claims 1, 4-14, 17-19, 28 and 31-33 are pending. By this Amendment, claims 2-3, 15-16, and 29-30 are cancelled, and claims 1, 4, 6, 10-11, 17, 19, 28, 31 and 33 are amended.

Rejection Under 35 U.S.C. § 119(e)

The Examiner asserted that Applicants have not complied with one or more conditions for receiving the benefit of the earlier filing date under 35 U.S.C. 119(e) because the provisional applications upon which the benefit of priority is claimed fail to provide adequate support under 35 U.S.C. 112 for the subject matter recited in instant claims 1-19 and 28-33 of the instant application.

It is well established that the priority claims under sections 119 and 120 are evaluated on a claim by claim basis. The evaluation of the particular priority date of a claim need only be considered under circumstances in which there is an intervening reference with a critical date between the actual filing date and the date of a priority claim. The issue is moot until such a

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reference becomes of record. See, for example, the discussion in the context of a foreign priority claim under section 119 in MPEP § 201.15. As no reference cited in the previous Office Action meets such requirements, this issue is moot and withdrawal of the rejection is requested.

Amendments to the Specification

The specification has been amended to correct use of trademarks, by capitalizing the trademark name and indicating trademark registration status. The specification has been amended to provide current status of reference applications. The abstract has been amended to conform to MPEP § 608.01(b).

Objection to the Specification – “Part of a ring group”

The Examiner asserted that the disclosure is objected to because the specification discloses that the R groups in the formulas  $(C_6R_1R_2R_3R_4)_n$  and on the 9-fluorenylidene group disclosed can be “part of a ring” and it is not clear what is meant by the term “part of a ring group”. One of ordinary skill in the art would understand that term “part of a ring group” refers to an atom or group that is bonded to other atoms or groups that form a ring system. For example, a carbon atom in a benzyl group is a part of a ring group. Particularly, for example, this terminology allows for  $R_1$  and  $R_2$ , as well as  $R_3$  and  $R_4$ , to jointly form a ring group. Applicants have attached to this response several web print outs relating to the term “part of a ring structure”. As used throughout the attached print outs, the term “part of a ring structure” relates to an atom or group bonded to other atoms or groups to form a ring system. Moreover, U.S. patent subclass 536/26.11 relates to compounds where “phosphorous is part of a ring”. For example, U.S. Patent No. 6,812,342 is classified in subclass 536/26.11, and Figs. 2 and 3 of the ‘342 patent depict a phosphorus group forming part of a ring structure (i.e., bonded to other atoms or groups in a ring). Thus, the term “part of a ring” structure or group is understood by

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one of ordinary skill in the art, and by the PTO, to mean an atom or group that is bonded to other atoms or groups to form a ring system. Since one of ordinary skill in the art would understand the scope of the term "part of a ring group", the specification is sufficiently clear.

Objection Under 37 C.F.R. 1.75(d)(1) and MPEP § 608.01(o)

The Examiner asserted that the specification is objected to as failing to provide proper antecedent basis for the claim subject matter under C.F.R. 1.75(d)(1) and MPEP § 608.01(o) because the term "belt" in claim 10 lacks antecedent basis in the specification. Claim 10 was amended to include the term "flexible belt", and therefore is now believed to satisfy 37 C.F.R. 1.75(d)(1) and MPEP § 608.01(o). Therefore, reconsideration and withdrawal of the objection of claim 10 under C.F.R. 1.75(d)(1) and MPEP § 608.01(o) is respectfully requested.

Rejection Under 37 U.S.C. §112

The Examiner rejected claims 3-6, 16-19, and 30-33<sup>a</sup>under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner asserted that claims 3, 4, 16, 17, 30 and 31 are indefinite in the phrase "R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub>, and R<sub>4</sub> comprise, each independently ... a part of a ring group." Claims 3, 16, and 30 have been cancelled; however, their limitations have been imported into independent claims 1, 11, and 28. Further, the Examiner asserted that claims 5, 18 and 32 are indefinite in the phrase "R<sub>5</sub>, R<sub>6</sub>, R<sub>7</sub>, R<sub>8</sub>, R<sub>9</sub>, R<sub>10</sub>, R<sub>11</sub> and R<sub>12</sub>, each independently...a part of a ring group."

One of ordinary skill in the art would understand that term "part of a ring group" refers to an atom or group that is bonded to other atoms or groups that form a ring system. For example, a carbon atom in a benzyl group is a part of a ring group. Particularly, for example, this terminology allows for R<sub>1</sub> and R<sub>2</sub>, as well as R<sub>3</sub> and R<sub>4</sub>, to jointly form a ring group. Applicants

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have attached to this response several documents relating to the term "part of a ring structure." As used throughout the attached documents, the term "part of a ring structure" relates to an atom or group bonded to other atoms or groups to form a ring system. Moreover, U.S. patent subclass 536/26.11 relates to compounds where "phosphorous is part of a ring." For example, U.S. Patent No. 6,812,342 is classified in subclass 536/26.11, and Figs. 2 and 3 of the '342 patent depict a phosphorus group forming part of a ring structure (i.e., bonded to other atoms or groups in a ring). Further, the term "part of a ...ring" is used in U.S. Patent No. 6,951,930 to Dempcy et al. at, for example, column 17, lines 40-45 and column 18, lines 42-46. Thus, the term "part of a ring" structure or group is understood by one of ordinary skill in the art, and by the PTO, to mean an atom or group that is bonded to other atoms or groups to form a ring system. Since one of ordinary skill in the art would understand the scope of the term "part of a ring group," the claims are definite.

Claims 4-6, 17-19, and 31-33 depend from claims 1, 11 and 28, respectively, and therefore are now also believed to satisfy 35 U.S.C. §112, second paragraph. Therefore, reconsideration and withdrawal of the rejection of claims 3-6, 16-19, and 30-33 under 35 U.S.C. §112 are respectfully requested.

Rejection Under 37 U.S.C. 102(b)

The Examiner rejected claims 28 and 32 under 35 U.S.C. § 102(b) as being anticipated by Bethell et al., J. Chem. Soc., Perkin Trans., 2, 1081-1086 (1996) (Bethell). The Examiner also asserts that claim 29 and 30 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims as "the prior art of record does not teach or suggest the charge transport comprising the linking group X recited in those claims." Claim 28 has been amended to include the limitations of claims 29 and 30, and is now believed to be in condition for allowance. Claim 32 depends from claim 28, and therefore is now also

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believed to be in condition for allowance. Therefore, reconsideration and withdrawal of the rejection of claims 28 and 32 under 35 U.S.C. § 102(b) is respectfully requested.

Rejection Under 37 U.S.C. 103(a)

The Examiner rejected claims 1, 5, 7-14, 18, 28, and 32 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. 2005/0265717 A1 (Tokarski), as evidenced by provisional application 60/483,726. The Examiner also asserts that claim 2, 15, and 29 "would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims," and claims 3, 4, 6, 16, 17, 19, 30, 31, and 33 "would be allowable if rewritten ... to include all of limitations of the base claim and any intervening claims" as "the prior art of record does not teach or suggest the charge transport comprising the linking group X recited in those claims." Independent claim 1 has been amended to include the limitations of claims 2 and 3; independent claim 11 has been amended to include the limitations of claims 15 and 16, and independent claims 29 and 30 are incorporated into claim 28. Therefore, independent claims 1, 11, and 28 are now believed to be in condition for allowance. Claims 5 and 7-10 depend from independent claim 1, claims 12-14 depend from independent claim 11, and claims 31 and 33 dependent from independent claim 28 and therefore are now also believed to be in condition for allowance. Therefore, reconsideration and withdrawal of the rejection of the pending claims under 35 U.S.C. § 103(a) is respectfully requested.

Double Patenting

The Examiner provisionally rejected claims 1, 5, 8, 9, 11-14, 18, 28, and 32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 and 35-42 of copending Application No. 10/900,785 ("the '785 Application"). It is believed that the amendments to the claims made hereby negate the double patenting provisional

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rejection of claims 1, 5, 8, 9, 11-14, 18, 28, and 32. Reconsideration and withdrawal of the provisional rejection of claims 1, 5, 8, 9, 11-14, 18, 28, and 32 due to nonstatutory obviousness-type double patenting are respectfully requested.

The Examiner also provisionally rejected claims 7 and 10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 and 35-42 of the '785 Application, in view of Diamond, Handbook of Imaging Material, pp. 395-396. It is believed that the amendments to the claims made hereby negate the double patenting provisional rejection of claims 7 and 10. Reconsideration and withdrawal of the provisional rejection of claims 7 and 10 due to nonstatutory obviousness-type double patenting are respectfully requested.

The Examiner provisionally rejected claims 1, 5, 7-14, 18, 28, and 32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 and 22-25 of copending Application No. 10/760,039. It is believed that the amendments to the claims made hereby negate the double patenting provisional rejection of claims 1, 5, 7-14, 18, 28, and 32. Reconsideration and withdrawal of the provisional rejection of claims 1, 5, 7-14, 18, 28, and 32 due to nonstatutory obviousness-type double patenting are respectfully requested.

Conclusion

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

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The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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